and traverse this rejection for at least the reasons previously of record and for the additional reasons set forth below.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing at least that there exists some suggestion or motivation to modify or combine reference teachings and that the references teach or suggest all of the claim limitations. M.P.E.P. § 2143. As is explained below, the cited reference combination fails to satisfy both of these requirements.

Citing *In re Kerkhoven*, 626 F.2d 846, 850, 205 U.S.P.Q. 1069, 1072 (C.C.P.A. 1980), the Examiner alleges that it would have been obvious to combine two compositions useful for the same purpose to form a third composition useful for the very same purpose. (Office Action dated May 8, 2002, page 3, lines 14-18.) Applicants respectfully submit, however, that to support an obviousness rejection there must be some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987) (citation omitted).

Here, the Examiner has not pointed to any teaching, suggestion, or incentive that would lead to Applicants' claimed invention. To the contrary, the Examiner has selected and combined piece-meal teachings of the cited references, an approach that *Kerkhoven* does not support. Thus, the Examiner's conclusory statements that the idea of combining the piece-meal teachings of components taught in the prior art to arrive at the claimed invention, "flows logically from their having been individually taught in the prior art," is not based upon the objective evidence of record. To the contrary, it is clear that the Examiner has used Applicants' invention as a guide in recreating it from the

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references cited, which is the essence of improper hindsight reconstruction and improper under § 103.

Notwithstanding the fact that *Takeshi* and *McEleney* are improperly combined, Applicants respectfully submit that, whether singly or together, these references fail to teach all of the limitations of Applicants' claims. As Applicants have pointed out, the reference combination fails to teach Applicants' "at least one ingredient chosen from pigments and fillers, wherein the at least one ingredient has been surface-treated by at least one water-repellant and oil-repellant agent." The Examiner must consider this element of Applicants' claims in determining patentability. M.P.E.P. § 2106(II)(C).

Further, Applicants respectfully disagree with the Examiner's suggestion that a showing of unexpected results is due from Applicants, as Applicants respectfully maintain that the Office has failed to establish a *prima facie* case of obviousness. In any event, in their previous response Applicants pointed to the specification of the instant application wherein a comparison between the inventive treated pigments/fillers and untreated pigments/fillers is tabulated. In the instant Office Action, however, the Examiner has failed to address this evidence.

Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness has been established by the cited reference combination, thus, Applicants request withdrawal of this rejection.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 8, 2002

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